

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) YOR920010552US1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on _____ Signature _____ Typed or printed name _____		Application Number 09/943,841	Filed August 31, 2001
		First Named Inventor Teresa B. Badura	
		Art Unit 3623	Examiner Peter H. Choi
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>53,352</u>		/Duane N. Moore/ Signature Duane N. Moore Typed or printed name (410) 573-6501 Telephone number June 19, 2007 Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:
Badura, et al.

Att'y. Docket No.: YOR920010552US1

Serial No.: 09/943,841

Group Art Unit: 3623

Filed: August 31, 2001

Examiner: Graysay, Tamara L.

For: ELECTRONIC METHOD FOR DETERMINING PROCUREMENT BUSINESS
STRATEGY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This pre-appeal brief request is being submitted together with a notice of appeal and is in response to the Office Action mailed April 5, 2007, setting a three-month statutory period for response. Therefore, this request is timely filed.

Claims 1-3, 5-8, 10, 12-16, and 18-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marsh, et al. (U.S. Patent No. 6,681,106), hereinafter referred to as Marsh, in view of Dalheimer ("LinuzTag 2001 Proceedings: Virtual Companies"), hereinafter referred to as Dalheimer.

Applicants respectfully traverse these rejections because the rejections contain two clear errors. First, the proposed combination of Marsh and Dalheimer miss the claim element of "evaluating a cost effectiveness of a mode of communication based on a first party's ability to communicate" (independent claims 1, 8, and 14). Secondly, the prior art of record miss the claimed element of evaluating and selecting a mode of communication from a plurality of modes of communication, wherein the modes of communication comprise at least two of telephone, facsimile, hard copy mail, electronic mail, and at least one on-line communication arrangement (independent claims 1, 8, and 14).

A. Missing Claim Element – evaluating a cost effectiveness of a mode of communication based on a first party’s ability to communicate.

The only portion of Dalheimer that discusses costs is provided in the second paragraph on page 2. Specifically, Dalheimer provides that “[s]ome aspects to consider when selecting communication channels are asynchronous vs. synchronous channels, latency, and cost” (Dalheimer, p.2, para. 2).

Nevertheless, Dalheimer misses the claimed element that such “cost” is evaluated *based on a first party’s ability to communicate*. Dalheimer does not evaluate the “cost” in any way, but merely states that cost is to be considered. Dalheimer fails to disclose whether the “cost” is the cost to the buyer, the cost to the seller, or the combined cost between the buyer and the seller. Any interpretation beyond “considering cost when selecting communication channels” in light of Dalheimer would be based on hindsight. The claimed invention goes well beyond considering cost and instead evaluates cost effectiveness based on a party’s ability to communicate.

Accordingly, Applicants submit that the “cost” considered in Dalheimer are not based on a first party’s ability to communicate. The costs considered in Dalheimer are not specific to a particular user. Therefore, it is Applicants’ position that Dalheimer misses the claimed element of “evaluating a cost effectiveness of a ... mode of communication of said modes of communication based on said first party’s ability to communicate” as defined in independent claims 1, 8, and 14.

B. Missing Claim Element – evaluating and selecting a mode of communication from a plurality of modes of communication, wherein the modes of communication comprise at least two of telephone, facsimile, hard copy mail, electronic mail, and at least one on-line communication arrangement.

The Office Action argues that Marsh discloses evaluating different *formats* (i.e., service plans) of communication (Office Action, p. 3, para. 3 – p. 5, para. 1). More specifically, the abstract of Marsh provides that a system and method for analyzing wireless communication records and for *determining optimal wireless communication service plans* is disclosed. A transceiver is configured to receive billing information

associated with a subscriber of a telecommunications service under a current rate plan. A storage unit stores the billing information. A processor processes the subscriber related billing information to produce organized data having a predefined format. The processor then *analyzes the processed data in relation to a plurality of rate plans of a plurality of telecommunications service providers, and determines at least one proposed rate plan that would save the subscriber telecommunication costs relative to the current rate plan.* A report of at least one proposed rate plan is then produced and provided to the subscriber, which enables selection of a best telecommunication service provider.

Additionally, citing column 8, lines 54-62 of Marsh, the Office Action asserts that the MAMBA system provides an analysis of periodically loaded wireless service usage of a given account or subscriber, and/or group of accounts or subscribers, and determines whether or not that subscriber, or group of subscribers, is on the optimal wireless service plan (Office Action, pp. 3-4, item 6(b)). The Office Action references various other portions of Marsh, which discuss calculating and comparing costs associated with different wireless service plans. For example, citing column 18, lines 34-45 of Marsh, the Office Action states that the relative attractiveness of a service plan instance is determined by comparing it to the corresponding actual billed usage of the current service plan; the specific measure, termed “efficiency”, is calculated as current plan costs/service plan instance estimated cost; if the efficiency factor is greater than 1, then the service plan instance is more cost effective than the other plan (Office Action, pp. 4-5, item 8(b)(iv)).

However, although the Office Action argues that Marsh discloses evaluating different *formats* (i.e., service plans) of communication, Marsh fails to teach or suggest evaluating different *modes* of communication.

To the contrary, the claimed invention provides a method of selecting from a plurality of modes of communication, comprising evaluating a cost effectiveness of a mode of communication of the modes of communication, wherein the modes of communication comprise at least two of telephone, facsimile, hard copy mail, electronic mail, and at least one on-line communication arrangement (independent claims 1, 8, and

14).

For example, as discussed in paragraph 0022 of Applicants' disclosure, question 300 inquires as to whether a supplier has a world wide web or other similar wide area network connection. If the supplier does not have such a connection, the invention determines whether the supplier at least has e-mail in item 301. If the supplier does not have e-mail, the invention determines whether the supplier at least as the ability to communicate by facsimile in item 302. Finally, if there is no facsimile, the invention determines whether the supplier can communicate with the corporation by telephone in item 303.

Accordingly, Applicants submit that Marsh does not teach or suggest evaluating and/or selecting from a plurality of *modes* of communication (e.g., telephone, facsimile, e-mail). Instead, Marsh discloses selecting from a plurality of *formats* (e.g., service plans, service plan packages, coverage areas) of ONE mode of communication (wireless telephone). Therefore, it is Applicants' position that Marsh fails to teach or suggest the claimed feature of "selecting from a plurality of modes of communication ... [and] evaluating a cost effectiveness of a mode of communication of said modes of communication ... wherein said modes of communication comprise at least two of telephone, facsimile, hard copy mail, electronic mail, and at least one on-line communication arrangement" as defined by independent claims 1, 8, and 14.

The Office Action argues that Marsh teaches evaluating a cost effectiveness of a standard mode of communication wherein said mode of communication comprises telephone (Office Action, p. 8, para. 2). However, Applicants submit that Marsh only discloses evaluating ONE mode of communication (i.e., wireless telephone). Marsh does not teach or suggest evaluating a mode of communication of a *plurality* of modes of communication (i.e., telephone AND facsimile, hard copy mail, e-mail, on-line communication arrangement).

Because Marsh only discloses evaluating ONE mode of communication (i.e., wireless telephone), Applicants submit that Marsh fails to teach or suggest the claimed feature of "evaluating a cost effectiveness of a mode of communication of said modes of

communication ... wherein said modes of communication comprise at least two of telephone, facsimile, hard copy mail, electronic mail, and at least one on-line communication arrangement” as defined by independent claims 1, 8, and 14.

Furthermore, because Marsh only discloses evaluating ONE mode of communication (i.e., wireless telephone), Applicants submit that Marsh fails to teach or suggest the claimed features of “repeating said evaluating for a different mode of communication of said modes of communication” as defined by independent claims 1 and 14, and “repeating said evaluating for a non-standard mode of communication of said modes of communication” as defined by independent claim 8.

Please charge any deficiencies and credit any overpayments to Attorney’s Deposit Account Number 50-0510.

Respectfully submitted,

Dated: June 19, 2007

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